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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/603,665 | 06/23/2000 | Caroline Barry | G-067US03REG | 8150 |

23557 7590 05/30/2003

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| EXAMINER |
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CHUNDURU, SURYAPRABHA

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| ART UNIT | PAPER NUMBER |
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1637

DATE MAILED: 05/30/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/603,665

Applicant(s)

BARRY ET AL.

Examiner

Suryaprabha Chunduru

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 79-126 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 79-126 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Acknowledgement is made for the request to establish continued prosecution application (RCE) (Paper NO. 20) filed on May 1, 2003. The request for RCE is accepted and is established with the status of the application as follows:

- a. the filing date of this RCE is established as 06/23/00;
 - b. Claims 79-126 are considered for examination.
2. Claims 1-79 are cancelled by amendment (Paper No. 15).

Response to Arguments

3. With reference to the rejection maintained in the previous office action under 35 USC 102(b), Applicants arguments and amendment are fully considered and the rejection is withdrawn in view of the amendment (Paper No. 15).

New issues

4. The instant disclosure is objected because of the following informalities:

- (i) in Claim 124 "asparagine" is misspelled as "aparagine".

Correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 85 and 126 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The instant claims recite "alanine at an amino acid position corresponding to position SED ID NO.5", which is indefinite and unclear whether the position of

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alanine corresponds to a particular position in SEQ ID NO.5 or any position in SEQ ID NO.5.

Amendment to clarify the position would obviate this rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

A. Claims 79, 85 and 126 rejected under 35 U.S.C. 102(b) as being anticipated by Zurawski et al. (5,696,234).

Zurawski et al. teach an isolated and purified recombinant polypeptide comprising a contiguous span of at least 6 amino acids shown as positions 1305-1312 of SEQ ID No. 5 of the instant invention (see column 8, lines 41-47, columns 29-30, SEQ ID No. 11, and sequence alignment, Patent database); Zurawski et al. also disclose producing antibody, which binds to an epitope of said polypeptides (see column 12, lines 44-49). Thus the disclosure of Zurawski et al. meets the limitations in the instant claims.

B. Claims 79, 85 and 126 rejected under 35 U.S.C. 102(e) as being anticipated by Ring et al. (5,811,267).

Ring et al. teach an isolated and purified recombinant polypeptide comprising a contiguous span of at least 6 amino acids shown as positions 1533-1539 of SEQ ID No. 5 of the instant invention (see column 4, lines 26-40, columns 41-44, SEQ ID No. 16, and sequence alignment,

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Patent database); Ring et al. also disclose producing antibody, which binds to an epitope of said polypeptides (see column 13, lines 61-67). Thus the disclosure of Ring et al. meets the limitations in the instant claims.

Conclusion

Claims 80-84, 86-125 are free of art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 703-305-1004. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and - for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Suryaprabha Chunduru
May 23, 2003


JEFFREY FREDMAN
PRIMARY EXAMINER